

REMARKS

This paper is responsive to an Office Action mailed May 14, 2008. Prior to this response, claims 1-47 were pending. After amending claims 1, 6, 8, 13-14, 19, 21, 25, 30, 32, 34, 37-38, 43, and 45, and canceling claims 2-5, 15-18, 26-29, and 39-42, claims 1, 6-14, 19-25, 30-38, and 43-47 remain pending.

In Section 2 of the Office Action claims 1, 14, 25, and 38 have been provisional rejected on the ground of nonstatutory obviousness-type double patenting in view of copending application Serial No. 10/670,949 in view of Djupsjobacka et al. ("Djupsjobacka"; EP 0854650) and Herpel ("Elementary Stream Management in MPEG-4"). In response, a Terminal Disclaimer is being filed concurrently with this response, disclaiming any term in the instant application extending beyond the expiration date of the co-pending application.

Claims 1-11, 13-35, and 37-47 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pereira et al. ("Pereira"; "The MPEG-4 Book") in view of Djupsjobacka. Regarding claims 1, 14, 25, and 38, the Office Action acknowledges that Pereira fails to disclose DVB multimedia with packetized DSM-CC U-U OC, where resources are retrieved from the DSM-CC U-U OC, but that Djupsjobacka discloses a DSM-CC OC address modification for the benefit received from a located URL. The Office Action states that it would have been obvious to use the DSM-CC U-U OC protocols taught by Djupsjobacka when transmitting MPEG-4 resources through an MPEG-2 TS, to enable benefits such as

hierarchical naming and program server assignment to individual names. This rejection is traversed as follows.

Claim 1 has been amended to include the subject matter of claims 2-5, now canceled. Claim 1, as amended, recites that a lid URI is located in an MPEG-2 TS, which is used to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC. Independent claims 14, 25, and 38 have been amended in a similar manner.

In Section 7.4, Pereira discusses the transport of MPEG-4 over MPEG-2. Packetized PES structures are encapsulated in a PS or elementary stream (ES), and then repackaged as TS packets in a TS (7.4.1.2 - 7.4.1.3). Pereira does not disclose an MPEG-2 TS with a DSM-CC U-U OC. Pereira does not disclose a lid URI in the MPEG-2 TS, or the use of the lid URI to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC.

Djupsjobacka discloses a communication system that uses an HTTP protocol URI in the transmission of interactive digital video broadcasting using DSM-CC protocols (pg. 3, ln. 41 through pg. 4, ln. 2, and pg. 7, ln. 2-25). Djupsjobacka does not disclose the use of a lid URI in a MPEG-2 TS, or the use of the lid URI to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC. In fact, the terms "lid", "MHP", "BIFS scene", and "object descriptor scene" do not appear to be mentioned.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to the Pereira would have been obvious to one of ordinary skill in the art in light of Djupsjobacka. This rejection appears to be most closely grounded in the

G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Djupsjobacka reference has been combined with the Pereira based upon the assumption that the combination discloses all the limitations recited in Applicant's claims 1, 14, 25, and 38. However, even if it would have been obvious incorporate DSM-CC into the Pereira, that combination still fails to describe a lid URI in the MPEG-2 TS, or the use of the lid URI to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC, as recited in claims 1, 14, 25, and 38. Claims 6-13, dependent from claim 1, claims 19-24, dependent from claim 14, claims 30-37, dependent from claim 25, and claims 43-47, dependent from claim 38, enjoy the same distinctions.

The Office Action states that it would have been obvious to apply the features of Djupsjobacka to the Pereira to enable benefits such as hierarchical naming and program server assignment to individual names. However, the concepts of hierarchical naming and program server assignment do not suggest the claim limitations recited in the Applicant's base claims, and missing in the cited prior art. More explicitly, this motivation does not suggest a lid URI in the MPEG-2 TS, or the use of the lid URI to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC. *A prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Pereira. However, there is nothing in the Djupsjobacka reference that suggests a modification based upon the use of lid URIs, BIFS scene descriptor streams, object descriptor

streams, or the embedding of these streams in a MHP OC, since Djupsjobacka disclose none of these features.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. “(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to use a lid URI in the MPEG-2 TS, or to use a lid URI to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an artisan were given the Pereira and Djupsjobacka references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of

success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of the Pereira and Djupsjobacka does not explicitly disclose every limitation of claims 1, 14, 25, and 38. Neither has a case been supported that Pereira can be modified to supply the missing limitations in view of Djupsjobacka, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1-11, 13-35, and 37-47 be removed.

The Office Action has rejected claims 12 and 36 under 35 U.S.C. 103(a) as unpatentable with respect to Pereira and Djupsjobacka, in view of Herpel. The Office Action acknowledges that Pereira does not disclose caching MPEG-4 resources, but that Herpel discloses such a feature, and that it would have been obvious to incorporate the teaching of Herpel into Pereira because MPEG-4 resources may need to be accessed at a later time. This rejection is traversed as follows.

Beginning on page 319, Herpel discloses a system decoder model (SDM), which is used to specify the behavior of a receiving MPEG-4 terminal. In Section IV C (page 321) Herpel states that MPEG-2 TSs may be used to encapsulate MPEG-4 streams. Three approaches are presented on page 322 for encapsulating MPEG-4 streams in an MPEG-2 TS, they are: 1) Single Stream Encapsulation; 2) FlexMux Stream Encapsulation; and, 3) Digital Storage Media.

In Section II-A, Herpel discloses OD components. As clearly stated by Herpel in the first paragraph under Section II (page 315, column 2), Herpel is describing an MPEG-4 system. This description is similar to the Applicant's explanation of Fig. 1. Herpel's description does not discuss the use of an MHP OC in an MPEG-2 TS, or a lid component in an MPEG-2 TS.

The obviousness rejection is based upon the assumption that Pereira and Djupsjobacka disclose all the limitations of amended claims 1 and 25. However, as noted above, the combination of the Pereira and Djupsjobacka fails to disclose the use a lid URI in the MPEG-2 TS, or the use a lid URI to provide a binding name and access scheme to BIFS scene or object descriptor streams in an MHP OC. Likewise, Herpel fails to disclose these limitations. Therefore, even if Herpel is combined with the Pereira and Djupsjobacka, the combination of three references still fails to explicitly describe every limitation of claims 1 and 25.

Neither does the motivation of accessing MPEG-4 resources at a later time suggest modifications to the Pereira that would make obvious the above-cited claim limitations. For example, there is no suggestion in the Herpel reference that lid URIs in an MPEG-2 TS can be

used to access embedded MPEG-4 resources in an MHP OC directory using a binding name and access scheme. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to the Pereira that would make all the limitations obvious, the Applicant requests that the rejection of claims 12 and 36 be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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